

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

**Glen Friedman et al.**

Serial        09/997,713

No.:

Filed:        November 29, 2001

For:        METHOD AND APPARATUS FOR  
              VIRTUAL EDITING OF  
              MULTIMEDIA PRESENTATIONS

Atty.        Docket    007287.00014  
No.:

Group Art Unit:    2179

Examiner:        Bautista, Xiomara L.

Confirmation        4318  
No.:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**Box AF**

U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Applicants respectfully request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated in the below remarks. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

***Remarks***

Having received and reviewed the Final Office Action dated November 28, 2007 and the Advisory Action dated March 18, 2008, Applicants respectfully submit that the standing rejections are based on one or more clear errors, and that the appeal process can be avoided through a pre-appeal brief review as set forth in the Official Gazette notice of July 12, 2005.

The pending rejections fail to address all the claim limitations, and exhibit clear factual and legal errors with respect to the cited references. The specific error relied upon in this Pre-Appeal Brief Request for Review includes the following:

- The Office made clear error in relying on Gupta *et al.* (U.S. Patent No. 6,546,405, “Gupta”), Boreczky *et al.* (U.S. Patent No. 6,366,296, “Boreczky”) and Bennett *et al.* (U.S. Patent No. 5,884,256, “Bennett”) in its rejection of claims 1-5 and 13-17 as argued in Applicant’s Amendment and Response dated February 29, 2008, at pp. 5-7. Claims 1, 6 and 18 recite annotations for portions of a file and playing back only the annotated or desired portions without user interaction. The Examiner concedes that Gupta and Boreczky do not specifically teach automatically displaying the plurality of desired portions without user interaction. Office Action dated November 28, 2007, at p. 7. Instead, the Examiner continues to assert that Bennett discloses such features. As noted previously, nowhere in Bennett is there any teaching or suggestion of playing back only annotated or desired portions *without user interaction*. The Examiner cites col. 25, ll. 37-67 and col. 26, ll. 1-33 as allegedly describing the above recited features. Applicants respectfully disagree. In fact, the cited passages of Bennett actually describes that the locating of a position on an audio tape corresponding to a particular question and answer requires *a court reporter to locate the requested question and answer*, e.g., by using a lexical search. Col. 26, ll. 14-19. Thus, contrary to the features recited in claim 1, Bennett requires *manual interaction* in order to playback a desired portion of an audio tape. In another example, Bennett describes that an “attorney may use the lexical searching capabilities of the attorney terminals to locate the desired Q & A’s, and may then automatically play the associated audio or video.” Col. 26, ll. 30-33. Thus, in order to play two desired portions, Bennett clearly describes that an individual must search for each corresponding Q & A. In contrast, claim 1 recites playing a second desired portion after a first desired portion *without user interaction*. The Advisory Action of March 18, 2008, continues to assert that Bennett describes playing back desired portions without user interaction without identifying any support for the

assertions made or responding to Applicants' remarks. Accordingly, the claims are allowable for at least these reasons.

- Additionally, independent claim 6 further recites, *inter alia*, "transmitting, from the location remote from said first location, to a viewing system the annotation file as a transmission that is distinct from the broadcast of the event, the annotation file configured to automatically display only the plurality of desired portions of the event without displaying the annotations and without displaying any other portion of the event, the second desired portion being automatically displayed after the first desired portion without user interaction." None of the cited references teach or suggest transmitting, from the location remote from said first location, to a viewing system an annotation file, as recited in claim 6. As the Office Action notes, Kelly merely discloses transmitting an activity table *to* an on-line database (i.e., the alleged location remote from the first location). In contrast, claim 6 recites transmitting an annotation file *from* the location remote from said first location. Significantly, the Advisory Action does not even address Applicants' remarks with respect to this feature. Kelly, Borezcky and Bennett are similarly deficient and thus, fail to cure the deficiencies of Gupta. Claim 6 is thus allowable for this additional reason.

While Applicants believe that the above points represent the clearest errors made by the Office, Applicants reserve the right to appeal on other bases and errors. Applicants further reserve the right to address the rejections of any other claims not identified above on appeal should the appeal of this case proceed after the Office's consideration of this paper.

***Conclusion***

All issues having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. However, if for any reason the review panel believes the application is not in condition for allowance or there are any questions, the review panel is invited to contact the undersigned at (202) 824-3156.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: April 26, 2008

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